UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,699	11/24/1999	KATSUNORI TSUTSUMI	990723/LH	6591

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EXAMINER
BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
2176	13

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/449,699	TSUTSUMI ET AL.	
	Examiner	Art Unit	
	William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 May 2004*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *12-21* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *12-21* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communications: RCE and amendment, both filed 5/18/2004, to the original application and priority papers, all filed November 24, 1999. Application claims benefit of priority filing dates: 12/24/1998, and **12/22/1998.**

2.   The rejection of claims 12, 14-17, 19-21 under 35 U.S.C. 103(a) as being unpatentable over Warmus has been withdrawn as necessitated by amendment.

3.   The rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Warmus and Aoyagi has been withdrawn as necessitated by amendment.

4.   The rejection of claim 18 under 35 U.S.C. 103(a) as being unpatentable over Warmus and Kanerva has been withdrawn as necessitated by amendment.

5.   Claims 12-21 are pending. Claims 12, 14, 17, 19, 20, 21 are independent claims.

Continued Examination Under 37 CFR 1.114

6.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/2004 has been entered.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set

forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 12, 14-17, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus**

et al, U.S. Patent No. 6,327,599 B1 issued 12/4/2001, in view of Mastie (hereinafter Mastie), U.S. Patent

No. 6,480,866 issued 11/12/2001.

In regard to independent claim 12, Warmus et al. teach converting means for converting a plurality of

documents formed by application programs into page document data to be outputted every page and storage

means for SPOOL-storing each of the page document data converted by the converting means. (Warmus et al.,

col. 5, lines 41-48: "The master and variable page files and the press command file are converted by a collator

and raster image processor (RIP) into bitmaps which may be stored in a memory. The stored bitmaps are used to

control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an

LCD display or the like so that the device displays pages having fixed and variable information thereon.")

Further, Warmus et al. teach output-subject setting means for designating desirable page document data

as output-subject document data SPOOL-stored in said storage means (Warmus et al., col. 8, lines 9-12: "A

database 108 is also developed by the publisher using the personal computer 54 specifying the content of

variable information to be placed in variable information areas, for example, the areas 110, 112 on the pages P1,

P4, respectively, of FIGS. 6a and 6b."), and for setting an output condition when each of said designated output-subject document data is outputted. (Warmus et al., col. 9, lines 57-59: "Following the block 158, a block 160 prompts the user to enter an indication of whether the image object is to be displayed in one of two display formats.")

Further, Warmus et al. teach output control means for outputting page document data designated from the respective page document data SPOOL-stored in the storage means based on the contents designated/set by the output-subject setting means in accordance with said output condition. (Warmus et al., col. 8, line 57 – col. 9, line 3: "The files 130, 132 are then converted into variable page files 134, 136. The files 134, 136 are identical to the files 130, 132, respectively, except that the data in each file identifying entries in the database are replaced by the actual data stored at such entries. . . . The print system 79 operates in response to the press commands in a press command file 140 and merges the page files 122, 137 and 138 (if no imposition is to be effected) or merges the page files 124 and 139 (if the pages are imposed) to create the finished books or book versions.").

Warmus et al. teach output-subject setting means forming a virtual document file and setting both designation information and an output condition inasmuch as Warmus et al. teach a bitmap equivalent to a virtual document file (Warmus et al., col. 5, lines 41-43) that would have inherently included designation information (*i.e.*, what was included in the file) and an output condition (*i.e.*, the format and order in which content was outputted).

Further, Warmus et al. teach outputting page document data in accordance with the output condition, and the outputted page document data is designated from the respective page document data SPOOL stored in the storage means based upon the content which is set by the output-subject setting means as the storage information in the virtual document file. (Warmus et al., col. 5, lines 43-47: "The stored bitmaps are used to control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an LCD display or the like so that the device displays pages having fixed and variable information thereon.")

Warmus et al. does not teach arbitrarily setting a desirable portion as a sequential number information adding area as an output condition when the designated data is outputted and adding (amending) a sequential number to every page to the area set as the sequential number information adding area. However, inasmuch as

Warmus et al. teaches formatting a book (Warmus et al., col. 5, lines 18-20), and it was well known in the art that book pages advantageously contain page numbers, the recited claim limitations would have been obvious to one of ordinary skill in the art at the time of the invention, providing a user of Warmus the benefit of sequential page numbering to aid in finding pages.

Warmus et al. does not specifically teach "individual" pages. However, Mastie teaches creation of a single output file from a plurality of inputted page files, each file can represent an individual page, and said files can be written in PDL. The correct sequence of pages is determined (i.e. page sequence for numbering), than a framework is created, and pages are modified accordingly to fit said framework (Mastie column 3 lines 38-50, Figure 5, column 7 lines 14-18, 24-32; compare with claim 12 *"individual pages"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Mastie to Warmus, providing Warmus the benefit of transforming separate pages into a single file to eliminate manual collating of pages (Mastie column 7 lines 16-19).

In regard to independent claim 14, claim 14 incorporates substantially similar subject matter as claimed in claim 12, and in further view of the following, is rejected along the same rationale:

Warmus et al. teaches converting the document data formed by the application program into image (graphics) page document data to be outputted. (Warmus et al., col. 5, lines 41-48.)

Further, Warmus et al. teaches SPOOL-storing into storage means a plurality of image (graphics) page document data converted by the converting means. (Warmus et al., col. 5, lines 41-43.).

In regard to dependent claim 15, Warmus et al. teach converting documents into page document data so as to be printed out as to each page. (Warmus et al., col. 5, lines 46-48.)

Further, Warmus et al. inherently teach SPOOL-storing page document data in correspondence with the virtual print designating document inasmuch as Warmus et al. teach printing page document data as noted above and such storage would have been necessary in order to get the right content on the page for which it was intended.

Further, Warmus et al. do not explicitly teach designating desirable page document data as print-out-subject document data. However, it was well known in the art to designate some pages and not others for printing, and one of ordinary skill in the art would have recognized that this feature gave the user the flexibility to print only the content the user wished to see. Therefore, it would have been obvious to one of ordinary skill in the art to designate desirable page document data as print-out-subject document data, and it further would have been obvious to set a print output condition when each of the designated print-out-subject document data was printed out because one of ordinary skill in the art would have recognized the benefits of being able to format the document for printing.

Further, Warmus et al. teach printing the document data (Warmus et al. col. 5, lines 43-48), and it would have been obvious to one of ordinary skill in the art to print the designated page document data in accordance with the print output condition because one of ordinary skill would have recognized that if the user had selected certain page document data, the user would want to print just that data according to whatever output conditions had been set.

In regard to dependent claim 16, Warmus et al. teach output-subject setting means forming a virtual document file and setting both designation information and an output condition inasmuch as Warmus et al. teach a bitmap equivalent to a virtual document file (Warmus et al., col. 5, lines 41-43) that would have inherently included designation information (*i.e.*, what was included in the file) and an output condition (*i.e.*, the format and order in which content was outputted).

Further, Warmus et al. teach outputting page document data in accordance with the output condition, and the outputted page document data is designated from the respective page document data SPOOL stored in the storage means based upon the content which is set by the output-subject setting means as the storage information in the virtual document file. (Warmus et al., col. 5, lines 43-47: "The stored bitmaps are used to control one or more demand printers and/or any other type of display device, such as a laser printer, a CRT, an LCD display or the like so that the device displays pages having fixed and variable information thereon.")

In regard to independent claim 17, claim 17 incorporates substantially similar subject matter as claimed in claim 12, and is rejected along the same rationale.

In regard to independent claim 19, claim 19 reflects the computer program product comprising computer executable instructions used for implementing the apparatus as claimed in claim 12, and is rejected along the same rationale.

In regard to independent claim 20, claim 20 reflects the computer program product comprising computer executable instructions used for implementing the apparatus as claimed in claim 14, and is rejected along the same rationale.

In regard to independent claim 21, claim 21 reflects the computer program product comprising computer executable instructions used for implementing the apparatus as claimed in claim 17, and is rejected along the same rationale.

10. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. and Mastie as presented in claim 12 above, and further in view of Aoyagi, U.S. Patent Number 5,88,103 issued 12/24/1996.**

In regard to dependent claim 13, Warmus et al. do not specifically teach masking an area for a page number and adding another page number based upon a virtual document. However, Aoyagi suggests such a limitation by pointing out the benefits of suppressing unnecessary details. (Aoyagi, col. 1, lines 15-23.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have output-subject setting means arbitrarily setting a desirable portion contained in Warmus's page document data (i.e. page numbering) as an output-suppressing area.

Further, given the benefits of using a mask taught by Aoyagi, noted above, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the output control means outputting as a mask such data corresponding to the area set as the output-suppressing area by the output-subject setting means.

11.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. and Mastie as presented in claim 12 above, and further in view of Kanerva et al., U.S. Patent No. 6,470,363 issued October 22, 2002 (previously cited reference).

In regard to dependent claim 18, Warmus does not specifically teach icons. However, Kanerva teaches Microsoft Office Binder, which utilizes icons reflecting various sections of a document (Kanerva et al. Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Kanerva to Warmus, providing a user of Warmus the benefit of icons for easy manipulation of document sections.

Response to Arguments

12.   Applicant's arguments with respect to claims 12-21 (directed to amended subject matter) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| Mastie | U.S. Patent No. 6,182,096 | issued | January 2001 |

14.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can

normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Joseph Feild, can be reached on **(703) 305-9792**.

Any inquiry of a general nature or relating to the status of this application should be directed to the

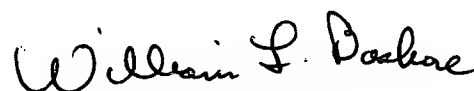Group receptionist whose telephone number is **(703) 305-3900**.

15.   **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703-872-9306) (for formal/after-final communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore
Patent Examiner, AU 2176
August 5, 2004